

REMARKS

Upon entry of the above amendments, this application will contain claims 1, 3, 6, 7, 9, 12, 16, and 18 pending and under consideration. The application was originally filed with claims 1-15. In a Preliminary Amendment, claims 2 and 13-15 were canceled and new claims 16-17 were added. In a Response filed on 5 August 2007, claims 5, 11, and 17 were canceled and claim 18 was added. In this Submission, the amendments submitted in the Response to Final Rejection, dated 16 January 2008, have been resubmitted because they were not entered. Claims 4 and 10 have been canceled, no new claims have been added, and claims 1, 3, 7, 9, 12, 16, and 18 have been amended. As discussed more fully below, it is believed that the pending claims are patentable. Reconsideration leading to allowance of all pending claims is requested.

I. Rejections under 35 USC §112

1. Claims 1, 3-6, 9, 10, 16 and 18 were rejected under 35 U.S.C. 112, first paragraph, for alleged failing to comply with the written description requirement. It was stated that no support for R1 representing allyl as recited in claims 1 and 3 was found in the application. The term allyl has been deleted from claims 1 and 2. Therefore this rejection is moot.

2. Claims 10, 12, and 16 were rejected under 35 U.S.C. 112, first paragraph, for alleged failing to comply with the enablement requirement. In order to advance this application to allowance, claim 10 has been canceled. Claim 12 has been amended by replacing the phrase "elevated hepatic lipase activity" with -hypercholesterolemia, hyperlipidemia, or atherosclerosis--. Support for this claim can be found in the present application at ¶0076. Claim 16 has been amended to depend from claim 18.

In light of the above comments and claim amendments, withdrawal of all rejections of the claims under 35 USC §112, first paragraph is requested.

II. Rejections under 35 USC 112, second paragraph

1. Claim 7 was rejected was noted as confusing. Claim 7 has been amended by adding --A compound-- in line 1 and replacing the "and;" in the last line with a period.

2. Claim 9 was rejected for a typographical error, i.e., lacking a space between claim and 1. Claim 9 has now been corrected.

3. Claim 10 was rejected. Claim 10 has been canceled; therefore, this rejection is moot.

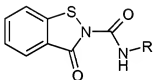
4. Claim 18 was rejected as unclear for failing to recite how and on what/whom the effective amount of compound is administered. Claim 18 has been amended to recite to a method of treating ... a mammal in need thereof administering an effective amount of benzisothiazole-3(2H)-one compound of formula I. Support for this amendment can be found in the application on page 6, ¶0076.

In light of the above, withdrawal of all rejections of the claims under 35 USC §112, second paragraph is requested.

III. Rejections under 35 USC §103

Claims 1, 4, 6-9 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (JP 48-029134 herein after Takahashi) alone.

Takahashi discloses fungicides represented by the formula below:



where R is H, CH₃, n-butyl, benzyl, and halo substituted benzyl.

In the presently claimed invention, the variable for substituent R1, which corresponds to the Takahashi structure above, are (C₄-C₁₂)haloalkyl, -CF₃, (C₁-C₈)alkylcycloalkyl, or (C₃-C₈)cycloalkyl. None of which are disclosed by Takahashi.

It was stated in the Office Action that substitution of a lower alkyl for hydrogen (i.e., a homolog) was not a patentable modification absent unexpected or unobvious results. However in light the amendment to R1, there is now no art recognized homolog in the claims to either the hydrogen or lower alkyl disclosed in Takahashi.

No further reasons have been articulated that the claimed invention is obvious over Takahashi. There is no suggestion that the combination of prior art elements yields a predictable result. This, as noted above, is not a simple substitution of one known, equivalent element for another to obtain predictable results. There is no suggestion that it would be "obvious to try" modifying the Takahashi compounds to arrive at the presently claimed invention. Further, there are numerous different substituents that could be used for the R group in the Takahashi. There is no teaching, motivation or suggestion in the cited art to modify Takahashi to arrive at the presently claimed invention.

Consequently it is maintained that the instantly claimed compounds are not structurally similar to those of Takahashi.

Claim 4 has been canceled; therefore, this rejection is moot. Claims 6 and 9 depend directly or indirectly from claim 1. Claim 7 has been amended to delete reference to compounds in which R1 is a substituted benzyl group or an alkylaryl group.

Claim 12, as amended to include a substituted benzyl and alkylaryl, is patentable over the cited art. In particular, Takahashi teaches compounds for *non-medical* fungicides. (Takahashi, page I, English trans., emphasis added.) Therefore, the invention claimed in claim 12 to a pharmaceutical formulation is both novel and non-obvious over Takahashi.

In light of the above comments and amendments withdrawal of the rejection of claims 1, 6-9 and 12 is requested.

IV. Claim Amendments

Claim 12 has also been amendment by incorporating the subject matter for the variables R1-R6 from claim 1. It is believed that this amendment does not add new matter. Claim 12 previously depended from claim 1, and thus included all the variables for R1-R6. Consequently, claim 12, as amended, should not require any additional searching.

Entry of this amendment is respectfully requested.

V. Conclusion

In light of the above comments and claim amendments, withdrawal of all outstanding rejections is requested. Applicants respectfully request timely examination of this application leading to allowance of all pending claims. The Examiner is invited to contact the undersigned attorney by telephone if there are any questions about this Response or other issues that may be resolved in that fashion.

Respectfully submitted,

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